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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,147	02/28/2002	James E. King	5681-04202	3470

7590

10/05/2005

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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/086,147	KING ET AL.	
	Examiner	Art Unit	
	Matthew Heneghan	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/10/03</u> | 6) <input type="checkbox"/> Other: _____  |

*PD*

### DETAILED ACTION

1. Claims 1-43 have been examined.

#### *Priority*

2. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/930,384, filed 15 August 2001. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen

months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference

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in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

3. The instant application claims priority to U.K. Application No. 0021456.9, filed 31 August 2000.

### ***Information Disclosure Statement***

4. The following Information Disclosure Statement in the instant application has been fully considered:

IDS filed 10 October 2003.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "85" has been used to designate both a lead line in figures 5 and 6 and "Save Smart Card Address" in figure 7.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: items 24' and 26' in figure 3; item 85 as portrayed in figures 5 and 6; oitem 92 in figure 6; item 192 in figure 9; and item 189 in figure 10.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(3) because the labels in figure 6 are difficult to comprehend, particularly in item 93.

8. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

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9. Claim 3 is objected to because of the following informalities: the term “the storage is configured to containing...” should be “the storage is configured to contain...”

Appropriate correction is required.

10. Claim 17 is objected to because of the following informalities: it is not clear what the transitional phrase in the claim is. It is being presumed that the limitations are being recited in an open-ended manner, beginning after the wording “having.” Appropriate correction is required.

11. Claim 29 is objected to because of the following informalities: it is not clear what the transitional phrase in the claim is. It is being presumed that the limitations are being recited in an open-ended manner, beginning after the phrase “ being operable to.”

Appropriate correction is required.

12. Claim 43 is objected to because of the following informalities: it is not clear what the transitional phrase in the claim is. It is being presumed that the limitations are being recited in an open-ended manner, beginning after the phrase “ wherein.” Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 29-37 and 39-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Each claim solely teaches to a computer program embodied on a carrier medium, which may include intangible transmission media (see Specification, p. 44, lines 5-7).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-43 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-36 of copending Application No. 09/930,384. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: All of the limitations in the claims of the instant application are disclosed in the claims of 09/930,384.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

15. Claims 1, 2, 5-7, 12-14, 17, 18, 22, 25, 26, 29, 30, 34, and 37-43 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,260,111 to Craig et al.

As per claims 1, 5, 14, 29, 38, 39, and 42, Craig discloses a system having a smart card that is used for access by a network computer. The Smart card includes storage for various data, and the controlling of access through the storing of protected information only via the smart card's CPU; user information (the network identity) and other configuration are stored therein (see column 6, lines 38-52). The smartcard interfaces with a network computer using memory (see column 5, lines 51-67).

As per claim 2, the user preferences and power management information constitute software configuration information (see also column 7, lines 36-39).

As per claims 6 and 7, keys may also be stored in the smart card's secure area (see column 7, lines 12-15).

As per claim 12, RAM is used for memory (see column 5, line 62).

Regarding claim 13, the smart card's CPU is a programmed microcontroller.

As per claims 17, 22, and 34, the network computer has a smart card port (see column 5, line 58) for reading the smart card.

As per claims 18 and 30, the network computer may write parameters to the smartcard (see column 8, lines 46-48).

Regarding claims 25, 26, 37, 40, 41, and 43, a smart card port inherently uses a microprocessor for I/O (the service processor).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3, 4, 9, 19, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,260,111 to Craig et al. as applied to claims 1, 5, 18, and 30 above, and further in view of U.S. Patent No. 6,108,789 to Dancs et al.

Craig states that information in the smart card is stored in memory, but does not disclose the format for saving the information thereon.

Dancs discloses a smart card for internet access where the configuration information is saved in one or more files, and suggests that allows data to be stored in regions of different size, and some sizes are more efficient than others (see column 17, lines 20-57).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of Craig by organizing the data on the smart card into files of varying sizes, as some sizes are more efficient than others.

17. Claims 8, 10, 11, 20, 21, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,260,111 to Craig et al. as applied to claims 5, 6, 17, and 29 above, and further in view of U.S. Patent No. 5,809,140 to Rubin et al.

Though Craig discloses the use of keys for retrieving information on the smartcard, Craig does not disclose the establishment of a session key for such retrievals.

Rubin discloses a session key establishment system for smart cards wherein a first key is sent, and a session key, derived from that input is established via a negotiating protocol (see column 7, lines 33-58). Rubin further discloses that this spares the need to store long-term secret keys (see column 3, lines 7-16).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Craig by employing the session key creation protocol disclosed by Rubin for enabling secure data transfers, as this spares the need to store long-term secret keys.

18. Claims 15, 23, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,260,111 to Craig et al. as applied to claims 1, 17, and 29 above, and further in view of Japan Patent Publication No. 07-058749 to Takiyasu et al.

Craig does not state where the MAC address is to be stored.

Takiyasu discloses the storing of the MAC address on the IC card, and suggests that this allows the card to be used for access on different terminals, such as a radio vs. wired terminal (see abstract).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a MAC address from the IC card, as disclosed by Takiyasu, as this allows the card to be used for access on different terminals.

19. Claims 16, 24, 27, 28, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,260,111 to Craig et al. as applied to claim 1, 17, and 29 above, and further in view of U.S. Patent No. 6,654,797 to Kamper.

Craig does not suggest the use of the smart-card in rack-mounted servers, or state how configuration on the smart-card is to be incorporated into the server upon boot-up.

Kamper discloses the use of smartcards in thin server configuration upon boot-up (see column 3, line 56 to column 4, line 19), and suggests that this allows for configuration without encountering the problems of locating, connecting, and securing the thin server (see column 1, lines 62-67). It is also noted that thin servers are rack-mountable (see column 1, lines 34-36).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use smartcards for thin server configuration upon boot-up, as this allows for configuration without encountering the problems of locating, connecting, and securing the thin server.

***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,822,434 to Caronni et al. discloses a system for using smartcards to enable session creation.

U.S. Patent No. 6,615,264 to Stoltz et al. discloses the use of several media, including smartcards, for using terminals.

U.S. Patent No. 6,816,965 to Moore et al. discloses the use of smartcards for policy enforcement.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

MEH



September 29, 2005

